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From: Duane M. Byers
Sent: Wednesday, July 21, 2010 6:51 PM
To: ninh.le@uspto.gov
Cc: Duane M. Byers
Subject: US Pat App No 10574003 - Information for discussion at telephone interview on July 22 - our ref 2590-152

Dear Examiner Le,

The Final Office Action has raised three issues:

1. A demand that we revise our specification to include various headings. Respectfully stated, there is no USPTO rule that applications include headings. For consistency, we propose to keep the application "as is" - which is line with the version filed around the world and for which the client has been granted patents in Europe, China, and many other countries.
2. An objection to our specification because it does not include the quoted claim language. Respectfully stated, there is no USPTO rule that the claim language be found verbatim in the specification. In this regard, we note that: (a) this issue was not raised in the first substantive Office Action, and (b) our Figures 3 and 7 in conjunction with our specification support each of the quoted phrases to which the Office Action objects. No such objections were raised in Europe or elsewhere.
3. An obviousness rejection of all claims based on Muller. We have thoroughly reviewed Muller and note that we have the following claim 1 features that are not found or suggested in Muller:
 - a) said side walls are positioned along a vertical plane,
 - b) the axis of symmetry of said cylinder is positioned horizontally,
 - c) the rotor is installed so that it rotates about a horizontal axis,
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 - e) a top side on which said outlet is situated.

In fact, Muller expressly teaches away from these claim 1 features. See Muller's column 9, lines 42-64, and Muller's Figs. 2-3.

It is also significant to note that Muller is in a different area of art (the art of making certain types of fibrets for specific applications).

The USPTO's position appears to be that one skilled in the art would turn Muller's Figure 2 device 90 degrees and arrive at our claim 1 invention. Our position is that:

- i) one skilled in the microparticles and nanoparticles art would not resort to Muller's "fibrets" invention - which was not successful, e.g., the Muller patent expired due to non-payment of maintenance fees, and
- ii) Muller specifically teaches that his device must be used in the non-rotated position.

Only improper hindsight would lead a person of skill in the microparticles and nanoparticles art

to resort to Muller and to rotate Muller's device 90 degrees, and, even when doing so, Muller's device for making fibrets would not work for its intended purpose (or even our purpose) because of the positioning of Muller's inlets, their sizes, the rotor and stator configuration and required sprockets, and the specifically designed star nozzle that would no longer be horizontal. Such a rotated configuration would create a mess and inconsistent/problematic fibrets. In fact, when reading Muller, our claimed design is counter-intuitive – which is evidence of non-obviousness.

Moreover, with respect to our claim 4, we note that our claimed first inlet perforations are quite different than Muller's specifically designed star nozzle. Muller does not disclose or suggest this claim 4 feature in any manner.

For at least the foregoing reasons, we submit that this application is in condition for allowance.

If the USPTO is not willing to allow the case at this time, then we will respectfully proceed with an appeal – but we request that you not re-open prosecution after you read our Appeal Brief. Instead, we respectfully request that you allow this matter to proceed to the Board for decision.

Respectfully submitted,
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